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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,394	12/12/2003	Peter Euteneuer	LWEP:121US	1710
7590	05/16/2007		EXAMINER	
Robert P. Simpson, Esq. Simpson & Simpson, PLLC 5555 Main Street Williamsville, NY 14221			PRITCHETT, JOSHUA L	
			ART UNIT	PAPER NUMBER
			2872	
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			05/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/735,394	EUTENEUER ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Joshua L. Pritchett	2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 05 March 2007.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-51 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-51 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 04 May 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)      4) Interview Summary (PTO-413)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)      Paper No(s)/Mail Date. \_\_\_\_\_.  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_      5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## DETAILED ACTION

This action is in response to Amendment filed March 5, 2007. Claim 1 has been amended and claim 51 has been added as requested by the applicant.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reinheimer (US 4,619,503).

Regarding claim 1, Reinheimer discloses an inverted microscope having a U-shaped microscope housing (Fig. 3), on one limb (T) whereof is provided a housing attachment surface (6) for attachment of a module (5), wherein the housing attachment surface is parallel to the base of the inverted microscope (Fig. 3) and wherein the module comprises a horizontally protruding based unit (Fig. 3) having a horizontal upper surface (Fig. 3) and a binocular tube (Fig. 3; col. 5 line 40), and a photo tube (6a; examiner assumes that the reference numeral 5a in Fig. 3 is misplaced and should be labeled 6a), with photo device placed thereon (col. 5 lines 45-

49) and the binocular tube and the photo tube are mutually exclusive and extend above the housing attachment surface when the module is removably attached to the housing attachment surface (Fig. 3) and wherein from the position of the binocular tube an unimpeded view of the specimen is permitted (Figs 3 and 4). Reinheimer lacks specific reference to both the photo tube and binocular tube being on the same surface. It would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the binocular tube to be on the same surface as the photo tube since it has been held that a mere change in shape of an element is generally recognized as being within the level of ordinary skill in art when the change in shape is not significant to the function of the combination. Further, one would have been motivated to select the shape of the module for the purpose of allowing the user to readily switch back and forth between the view provided by the binocular tube and the phototube without having to change positions.

Regarding claim 2, Reinheimer discloses the module is embodied as a one-piece combination module (Fig. 3) and has on its underside a module attachment apparatus that is configured to be removably attached to the housing attachment surface (col. 4 lines 28-32).

Regarding claims 3, 8 and 51, Reinheimer teaches the vertical optical axis of the photo beam beam bundle, extending in the one limb penetrates through a first optical deflection element after entering the base unit and then pass through the first tube lens arrange in the photo tube with photo device attached while the observation beam deflected at the optical deflection element after passage through a second tube lens and after deflection at a second deflection element enters the binocular tube (col. 5 lines 40-49). Reinheimer teaches the claimed invention except for binocular tube and photo tube being reversed. It would have been obvious to one

having ordinary skill in the art at the time the invention was made to reverse the binocular tube and the photo tube, since it have been held that a mere reversal of working parts of a device involves only routine skill in the art. One would have been motivated to reverse the binocular tube and the photo tube for the purpose of eliminating any aberrations introduced into the observed image by deflecting the observation beam, thus allowing the user to see a sharper image.

Regarding claims 4 and 9-11, Reinheimer teaches the invention as claimed but lacks optical deflection element brought into and out of working position in the Fig. 3 embodiment. Reinheimer teaches an optical deflection element (25) moving in and out of a working position (Fig. 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Reinheimer invention include in the Fig. 3 embodiment the ability to move an optical deflection element into and out of a working position for the purpose of determining providing all light to either the viewer or an image capturing device so that the image views or captured is brighter due to all the intensity going to one instead of splitting the intensity between the two.

Regarding claims 5 and 12, Reinheimer discloses an infinity beam exists in the region of an attachment surface of the module attachment apparatus (Fig. 3).

Regarding claims 6, 7 and 19-48, Reinheimer teaches the invention as claimed but lacks reference to different corrections for the photo tube and the binocular tube. It is extremely well known in the art to use periplan correction for flat field eyepieces and HC correction for magnetic recording media. Official Notice is taken. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Reinheimer invention

include the corrections as known in the art for the purpose of producing a clear image to both the viewer and the photo device.

Regarding claims 13-18, Reinheimer teaches an infinity beam exists in the region of an attachment surface of the module attachment apparatus (Fig. 3).

Regarding claims 49 and 50, Reinheimer teaches the passage through a second tube is parallel to the attachment surface (Fig. 5b). Fig. 5b shows the elongated portion A would have light traveling parallel to the surface 30 similar to the Fig. 1 of the current application.

### *Response to Arguments*

Applicant's arguments, see Amendment, filed March 5, 2007, with respect to the rejection(s) of claim(s) 1 under 35 U.S.C. 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration of the newly amended claim language, a new ground(s) of rejection is made in view of 35 U.S.C. 103. Applicant amended the claim language to require a certain configuration not specifically taught by Reinheimer. Reinheimer suggests the location of the binocular tube is not essential to the invention as shown by Figs. 1a-1c. Further it has been held that a change in shape is within the skill of one of ordinary skill in the art. The modification from the Reinheimer reference to the applicant's claim language only requires a change in the shape of the upper surface of the module and therefore the change is obvious.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L. Pritchett whose telephone number is 571-272-2318. The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone Allen can be reached on 571-272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Joshua L Pritchett  
Examiner  
Art Unit 2872